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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Attorney Docket No.: RPS920010141US1

In re Application of:

THOMAS J. PROROCK

Serial No.: 09/943,941

Filed: 31 AUGUST 2001

For: METHOD AND SYSTEM FOR PROVIDING INCENTIVE AWARD INFORMATION TO A CUSTOMER

Los Los Los Los Los Los Los Los Los Los

Examiner: CARLSON, J.

Art Unit: 3622

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The present Brief is submitted in support of the Appeal in the above-identified application.

Please charge IBM Corporation's Deposit Account **50-0563** in the amount of \$500.00 for the submission of the present Brief. No additional fee or extension of time is believed to be required; however, in the event an additional fee or extension of time is required, please charge that fee to IBM Corporation's Deposit Account **50-0563**.

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TABLE OF CONTENTS

| | |
|---|---|
| TABLE OF CONTENTS | 2 |
| REAL PARTY IN INTEREST | 3 |
| RELATED APPEALS AND INTERFERENCES | 3 |
| STATUS OF THE CLAIMS | 3 |
| STATUS OF AMENDMENTS | 3 |
| SUMMARY OF THE CLAIMED SUBJECT MATTER | 3 |
| GROUND OF REJECTION TO BE REVIEWED ON APPEAL | 4 |
| ARGUMENT | 5 |
| I. <i>Sloane</i> does not teach or suggest the claimed determining step | 5 |
| II. No motivation to combine <i>Sloane</i> and <i>Harms</i> | 6 |
| CLAIMS APPENDIX | 9 |

REAL PARTY IN INTEREST

The present application is assigned to International Business Machines Corporation, the real party of interest.

RELATED APPEALS AND INTERFERENCES

No related appeal is presently pending.

STATUS OF THE CLAIMS

Claims 1-4 and 9-14, which were finally rejected by the Examiner as noted in the Final Office Action dated October 12, 2004 and in the Advisory Action dated November 18, 2004, are being appealed.

STATUS OF AMENDMENTS

An Amendment after Final was submitted on October 22, 2004 in response to the Final Office Action dated October 12, 2004.

SUMMARY OF THE CLAIMED SUBJECT MATTER

One objective of the claimed invention is to entice a customer to purchase an item that can immediately qualify the customer to receive an incentive award. As described in page 8, line 28 - page 9, line 2 of the specification, when getting close to an incentive award plateau, the customer may receive information related to an opportunity for receiving an incentive award such as "You are a \$10.00 purchase away on any breakfast item to receive a free milk" or "You are a \$10.00 purchase away on any paperback to receive a new magazine."

As recited in Claim 1 and similarly in Claim 10, customer information of a customer is initially obtained from an input device (page 9, lines 8-9; block 31 of Figure 3). The customer information is then transmitted to a remotely located host computer (page 9, lines 9-11; block 32 of Figure 3). In response to the receipt of a scanned product code at the input device, the scanned product code are transmitted from the input device to the host computer (page 9, lines 17-20; block 35 of Figure 3). A determination is then made within the host computer as to

whether or not an immediate purchase of a product associated the said scanned product code qualifies the customer for an award based on the located incentive award information (page 9, line 24 - page 10, line 3; blocks 37-39 of Figure 3). In a determination that an immediate purchase of a product associated with the scanned product code qualifies the customer for an award, information related to an opportunity for receiving the award are transmitted from the host computer to the input device, and such information are displayed on the input device (page 10, lines 3-7; block 40 of Figure 3).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The Examiner's rejection of Claims 1-4 and 9-14 under 35 U.S.C. § 103(a) as being unpatentable over *Sloane* (US 5,918,211) in view of *Harms et al.* (US 6,070,147).

ARGUMENT

The Examiner's rejections of Claims 1-4 and 9-14 are not well-founded and should be reversed.

I. *Sloane* does not teach or suggest the claimed determining step

Claim 1 (and similarly Claim 10) recites a step of "determining within said host computer whether or not an immediate purchase of a product associated with said scanned product code qualifies said customer for an award based on said located incentive award information."

Sloane teaches a method and apparatus for influencing consumer purchasing decisions at the point-of-purchase (col. 1, lines 11-14). According to *Sloane*, a customer will be alerted of a product promotion for a product as the product is being scanned by the customer (col. 3, lines 20-22). The customer will also be alerted of a product promotion for a competitive product or a product related to the consumer's scanned product (col. 3, lines 24-26). Thus, *Sloane*'s customer alert is sent to a consumer solely based on the product being scanned by the consumer, as in whether or not the consumer's scanned product is associated with some kind of promotion.

In contrast, the claimed determining step determines whether or not an immediate purchase of a product will qualify the customer for an award based on the located incentive award information. Thus, the claimed determining step determines whether to send an alert to a consumer or not by associating the consumer's scanned product with the located incentive award information of the consumer. The claimed determining step is not based on the consumer's scanned product alone.

Sloane also teaches a method and apparatus of influencing consumer purchasing decisions even before a consumer starts shopping. For example, *Sloane* offers discounts, promotions or other information to a consumer after the consumer had scanned his/her frequent shopper card before the consumer starts shopping (col. 9, lines 5-19). Thus, *Sloane* attempts to influence a consumer's shopping behavior even before any shopping has begun.

In contrast, the claimed determining step determines whether or not an immediate purchase of a product qualifies the customer for an award based on the located incentive award information. Thus, the claimed determining step attempts to influence a consumer's shopping behavior at the point-of-purchase and not before any shopping has begun.

The claimed determining step is not taught or suggested by *Harms* either. Because Claim 1 (and similarly Claim 10) recites novel features that are not taught or suggested by the cited references, the § 103 rejection is improper.

II. No motivation to combine *Sloane* and *Harms*

Under MPEP § 706.02(j), in order to establish a *prima facie* case of obviousness three criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claimed limitations.

As mentioned above, *Sloane* teaches a method for influencing consumer purchasing decisions at the point-of-purchase and/or before any purchase has occurred. *Harms*, on the other hand, teaches a method for administering a loyalty marketing program by using a government-issued identification card as the frequent buyer redemption card (col. 1, lines 5-12). In fact, based on the Examiner's response on page 4 of the Final Office Action, the Examiner also agreed that *Harms*' teachings do not include influencing consumer purchasing decisions. Since *Sloane* and *Harms* are related to different aspects of retail sales, there is really no suggestion or motivation to modify *Sloane* by *Harms* or to combine reference teachings for the purpose of § 103 rejection.

But assuming *arguendo* that there is motivation to combine the teachings of *Sloane* and *Harms*, *Harms*' teachings of earning reward points do not work with *Sloane*'s teachings of influencing consumer purchasing decisions at the point-of-purchase.

Harms teaches two different awarding criteria, the first criterion being based on the number of purchases (or points) within a given time-frame (col. 8, lines 31-32 and lines 40-42), and the second criterion being based on the number of visits within a given time-frame (col. 8, lines 48-52). More importantly, *Harms* teaches an award to be issued to a consumer when the conditions for granting an award are satisfied. For example, the award can be issued by printing an award certificate and mailing it to the consumer (col. 11, lines 27-29), or the retailer can issue the reward to the consumer directly at the point of sale (col. 11, lines 29-31).

As mentioned above, *Sloane* teaches that a customer will be alerted of a product promotion for a product as the product is being scanned by the customer (*i.e.*, at the point of purchase). *Sloane* also teaches that discounts, promotions or other information can be offered to the consumer before the consumer starts shopping (*i.e.*, before the point of purchase). Thus, the earning of points according to *Harm* is really not applicable to *Sloane*'s product promotion scheme because *Sloane*'s customer alert is solely based on the product being scanned by the consumer and not anything else from the consumer. Also, *Harms* teaches an award to be issued to a consumer when the conditions for granting an award are satisfied (*i.e.*, at the point of sale, which is after the point of purchase). Hence, *Harms*' teachings of earning reward points do not work with *Sloane*'s teachings of influencing consumer purchasing decisions at the point-of-purchase. As such, the § 103 rejection is improper.

CONCLUSION

For the reasons stated above, Appellant believes that the claimed invention clearly is patentably distinct over the cited references and that the rejections under 35 U.S.C. § 103 are not well-founded. Hence, Appellant respectfully urges the Board to reverse the Examiner's rejection.

Respectfully submitted,



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CLAIMS APPENDIX

1. A method for providing incentive award information to a customer, said method comprising:

obtaining customer information of a customer from an input device;

transmitting said customer information to a remotely located host computer, wherein said host computer locates incentive award information associated with said customer information;

in response to the receipt of a scanned product code at said input device, transmitting said scanned product code from said input device to said host computer;

determining within said host computer whether or not an immediate purchase of a product associated with said scanned product code qualifies said customer for an award based on said located incentive award information;

in a determination that an immediate purchase of a product associated with said scanned product code qualifies said customer for an award, transmitting information related to an opportunity for receiving said award from said host computer to said input device and displaying said information related to said opportunity for receiving said award on said input device.

2. The method of Claim 1, wherein said method further includes

in a determination that an immediate purchase of a product associated with said scanned product code does not qualify said customer for an award, determining whether or not an immediate purchase of said product places said customer within a predetermined range to win said award; and

in a determination that an immediate purchase of said product places said customer within a predetermined range to receive said award, transmitting information related to said predetermined range to receive said award from said host computer to said input device, and displaying said information related to said predetermined range to receive said award on said input device.

3. The method of Claim 2, wherein said method further includes receiving a confirmation of a purchase of said product at said input device.

4. The method of Claim 3, wherein said method further includes updating said incentive award information within said host computer only after the receipt of said purchase confirmation.

5. cancelled

6. cancelled

7. cancelled

8. cancelled

9. The method of Claim 1, wherein said input device is a portable input device.

10. A system for providing incentive award information to a customer, said system comprising:

an input device for obtaining customer information from a customer;

means for transmitting said customer information to a remotely located host computer, wherein said host computer locates incentive award information associated with said customer information;

in response to the receipt of a scanned product code at said input device, means for transmitting said scanned product code from said input device to said host computer;

means within said host computer for determining whether or not an immediate purchase of a product associated with said scanned product code qualifies said customer for an award based on said located incentive award information;

in a determination that an immediate purchase of a product associated with said scanned product code qualifies said customer for an award, means for transmitting information related to an opportunity for receiving said award from said host computer to said input device and means for displaying said information related to said opportunity for receiving said award on said input device.

11. The system of Claim 10, wherein said system further includes

in a determination that an immediate purchase of a product associated with said scanned product code does not qualify said customer for an award, means for determining whether or not an immediate purchase of said product places said customer within a predetermined range to win said award; and

in a determination that an immediate purchase of said product places said customer within a predetermined range to receive said award, means for transmitting information related to said predetermined range to receive said award from said host computer to said input device, and means for displaying said information related to said predetermined range to receive said award on said input device.

12. The system of Claim 11, wherein said system further includes means for receiving a confirmation of a purchase of said product at said input device.

13. The system of Claim 12, wherein said system further includes means for updating said incentive award information within said host computer only after the receipt of said purchase confirmation.

14. The system of Claim 10, wherein said input device is a portable input device.